

REMARKS

In the Office Action of Paper No. 7, claims 1-27 were rejected under 35 U.S.C. §102 as being anticipated by the disclosure of U.S. Pat. No. 6,430,542, issued to Moran (hereinafter "Moran").

In response to the Office Action, Applicant has amended independent claims 1, 8, 16, 21,23, and 26 to clarify that the invention pertains to a plurality of long-term care insurance options, rather than merely a plurality of other types of insurance options. In view of such amendments and the following arguments, Applicant request reconsideration of the rejections set forth in the Office Action of Paper No. 7.

Claims 1-27 are Not Anticipated by Moran:

A claim is only anticipated "if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131.01 *quoting* Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). Moran clearly fails to disclose each and every element of each of the pending claims.

As the title of the Moran patent suggests, the disclosure therein pertains to a computer-implemented program for financial planning and advice. More particularly, the disclosure of the Moran patent pertains to the analysis of the value and distribution of a person's estate at the time of the person's death. In contrast, the present invention pertains to the estimation of the value of a person's estate following the person's receipt of long-term care, impacted by various long-term care insurance options chosen or not chosen, and the economic impact to such value resulting from the long-term care costs.

These differences are significant in that the computer-implemented program disclosed in the Moran patent only suggests that long-term care be considered a "situation" affecting an estate's valuation (most likely as merely an expense). Thus, as discussed below in reference to particular claims, the Moran Patent fails to disclose or suggest any computer program or method that performs or includes the limitations of the presently claimed invention.

Regarding independent claim 1 of the present invention, this claim requires, among other things, a storage routine that is adapted and configured to store user-controlled data indicative of a hypothetical scenario of future long-term care costs and one of a plurality of long-term care insurance options. Moreover, claim 1 requires a process routine that includes calculations to account for hypothetical tax consequences resulting from a sale of a portion of personal assets to pay the long-term care costs in a manner to determine the economic impact of the long-term care costs on the personal assets. Thus, while the Moran patent discloses insurance, albeit not long-term care insurance, and mentions long-term care, it fails to suggest a plurality of long-term care insurance options. Moreover, although the Moran patent also discloses "contributing factors" that include federal and state tax, it fails to suggest any calculation to account for hypothetical tax consequences resulting from the sale of a portion of the personal assets to pay long-term care costs. Because the Moran patent fails to disclose these elements and limitations, the anticipation rejection of claim 1 based thereon is improper and should be withdrawn. Moreover, because claims 2-7 are dependent upon claim 1, it follows then that claims 2-7 are also not anticipated by the Moran patent.

In addition to the above-mentioned reasons, Claim 2 is not anticipated by the Moran patent for the additional reason that claim 2 requires a process routine that is adapted and configured to perform calculations that account for hypothetical unrealized investment opportunity resulting from the absence of the portion of the personal assets due to the sale of the portion of the personal assets to pay long-term care costs. In the Office Action, it is suggested that the Moran patent somehow discloses this limitation in column 26, lines 55-64. However, this passage at most discloses that the simulator of Moran determines numerical remedies that will substantially eliminate future resource needs or unnecessary surpluses, but fails to disclose any calculations that account for a hypothetical unrealized investment opportunity. Thus, for this additional reason, the Moran patent fails to anticipate claim 2, as well as claims 3 and 4, which are each dependent upon claim 2.

Furthermore, in addition to being dependent upon claim 1, claim 5 also includes the limitation that the computer program include a process routine adapted and configured for using the stored data to determine an uninsured economic impact by accounting for hypothetical tax consequences resulting from a sale of a second portion of the personal assets to pay the long-term care costs. Again, the Moran patent fails to disclose or suggest any calculations to account for hypothetical tax consequences resulting from the sale of any assets used to pay long-term care costs. Thus, Moran clearly fails to disclose the calculation of both an insured economic impact and an uninsured economic impact of long-term care costs on personal assets, as is required by claim 5. Thus, for these additional reasons, the Moran patent further fails to anticipate claim 5, as well as claims 6 and 7, which are each dependent upon claim 5.

Like claim 1, independent claim 8 requires a storage routine adapted and configured to store user control data indicative of a hypothetical scenario of future long-term care costs and one of a plurality of long-term care insurance options. As mentioned above in reference to claim 1, the Moran patent fails to disclose this limitation. Moreover, claim 8 also requires a process routine that is adapted and configured for using the stored data to determine the insured economic impact by including calculations to account for periodic premium payments and monetary insurance benefits received. The Moran patent makes no reference of monetary insurance benefits received in any process routine used to calculate a first portion of personal assets hypothetically sold to pay long-term care costs. Thus, because the Moran patent fails to disclose these limitations, the anticipation rejection of claim 8 based thereon is improper and should be withdrawn. Moreover, because claims 9-15 are each dependent upon claim 8, it follows then that, for these same reasons, claims 9-15 are also not anticipated by the Moran patent.

In addition to the limitation of claim 8, claim 10 includes additional limitations that further avoid anticipation. In particular, similar to claim 2, claim 10 requires a process routine that includes calculations to account for hypothetical unrealized investment opportunity resulting from the hypothetical sale of the first portion of the personal assets. Moreover, the process routine is required to be configured to determine the uninsured economic impact by including calculations to account for hypothetical unrealized investment opportunity resulting from the hypothetical sale of a second portion of the personal assets hypothetically sold (such uninsured economic impact being independent of any periodic premium payments and any monetary insurance

benefits received). As discussed above, the Moran patent fails to disclose these limitations, and for such additional reasons fails to anticipate claim 10. For these same reasons, it follows then that claims 11-15, being dependent upon claim 10, are also further not anticipated by the Moran patent.

Claim 12, in addition to being dependent upon claim 10 and 8 discussed above, further includes the limitation that the hypothetical tax consequences be accounted for by assuming that any long-term care costs in excess of the monetary insurance benefits and all of the insurance premiums are paid for by the sale of the first portion of the personal assets. In rejecting this claim, the Office Action refers to the same paragraph (column 26, lines 23-42) of the Moran patent that allegedly discloses the limitations of claim 8. However, this passage fails to disclose any assumption that any long-term care costs in excess of any monetary insurance benefits and any insurance premiums are paid for by any portion of any personal assets. Thus, for this additional reason, the Moran patent fails to anticipate claim 12.

Independent claim 16 requires, among other things, a storage routine that is adapted and configured to store user-controlled data indicative of a hypothetical scenario of future long-term care costs and of one of a plurality of long-term care insurance options. As discuss above, the Moran patent fails to disclose or suggest this limitation. Moreover, claim 16 further requires a process routine that is adapted and configured to calculate a portion of the personal assets hypothetically sold to pay the long-term care costs. However, the Moran patent fails to disclose or suggest the sale of any assets to pay for long-term care cost. Thus, because the Moran patent fails to disclose these limitations, the anticipation rejection of claim 16 is improper and should

be withdrawn. Moreover, it follows then that claims 17-20, being dependent upon claim 16, are also not anticipated by the Moran patent.

Claim 21 is directed to a method and requires a step of determining an economic impact of the long-term care costs on personal assets based upon acquired data by performing calculations to account for hypothetical tax consequences resulting from a sale of a portion of the personal assets to pay the long-term care costs. For the reasons discussed above in reference to claim 1, the Moran patent fails to disclose or suggest this limitation and therefore fails to anticipate claim 21. Moreover, because claim 22 is dependent upon claim 21, it follows then that claim 22 is also not anticipated by the Moran patent.


Independent claim 23 is also directed to a method and requires, among other things, calculations of a first portion of the personal assets hypothetically sold to pay the long-term care costs and calculations to account for periodic premium payments and monetary insurance benefits received. Moreover, claim 23 requires calculations of a second portion of the personal assets hypothetically sold to pay the long-term care costs, and requires the uninsured economic impact to be independent of any periodic premium payments and any monetary insurance benefits received. These limitations are similar to the limitations discussed above in reference to claim 8. As such, for the same reasons discussed above in reference to claim 8, it follows then that the anticipation rejection of claim 23 is improper and should be withdrawn. Likewise, because claims 24 and 25 are dependent upon claim 23, it follows then that these claims are also not anticipated by the Moran patent.

Independent claim 26, similar to claim 16, requires the determination of the economic impact to include performing calculations of a portion of the personal assets hypothetically sold to pay long-term care costs. Once again, the Moran patent fails to disclose the sale of any assets to pay for long-term care costs. Because the Moran patent fails to disclose these limitations, the anticipation rejection of claim 26 is improper and should be withdrawn. Likewise, it follows then that claim 27, being dependent upon claim 26 is also not anticipated by the Moran reference.

Conclusion

In view of the above, Applicant submits that the claims presently pending in this application are allowable over the prior art and requests that the rejections thereof be withdrawn.

Respectfully submitted,



Clyde L. Smith, Reg. No. 46,292
Thompson Coburn LLP
One US Bank Plaza
St. Louis, Missouri 63101
Telephone: 314-552-6338
Fax: 314-552-7338